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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,995	09/23/2003	Safaa H. Hashim	021756-060140US	4520

51206 7590 08/18/2009
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EXAMINER

SEREBOFF, NEAL

ART UNIT	PAPER NUMBER
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3626

MAIL DATE	DELIVERY MODE
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08/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/670,995	Applicant(s) HASHIM, SAFAA H.	
	Examiner NEAL R. SEREBOFF	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/28/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. In the Amendment dated 4/30/2009, the following has occurred: Claims 29 – 31 have been amended; Claims 32 – 44 have been added; Claims 4 – 7 and 9 – 19 have been canceled.
2. Claims 1 – 3 and 8 have been previously canceled.
3. Claims 20 – 44 are pending.

Notice to Applicant

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 101

5. Claims 32 – 37 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 32 – 37 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to a machine (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski*, F.3d , 88 U.S.P.Q.2d 1385 (2008). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). The process steps in claims (32 – 37) are not tied to a machine nor do they execute a transformation. Thus, they are non-statutory.

Claim Rejections - 35 USC § 112

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6. Claims 38 – 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 38 includes the limitation, “as perceived by a person using the desktop visual metaphor.” The Examiner is unsure how the perceptions of a user can be quantified so that all users can understand what “a desktop visual metaphor” may entail. Therefore, the Examiner understands “a desktop visual metaphor” to be a web page. Additionally, “operate substantially similar to corresponding elements of an operating system desktop” is not clear. Beyond the term of degree “substantially similar” that is not defined by the claim, “corresponding elements of an operating system desktop” is also not defined. Are the elements the cursor or the background color? Is this a Windows or Mac or UNIX or BeOS operating system? The Examiner understands that “corresponding elements of an operating system desktop” is non-functional descriptive information. Claims 39 - 44 are rejected for the same reasons as they depend upon claim 38.

Claim Rejections - 35 USC § 102

7. ***Claims 4 – 7, 20 – 28, 32, 34 and 35 are*** rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention, ZeBU Corporation software, herein referred to as ZeBU.

8. As per claim 20, ZeBU teaches a system for facilitating communication among participants in an insurance-underwriting process, the system comprising:

- At least one database adapted to store a plurality of data related to the insurance-underwriting process (ZeBU software, as evidenced by ZeBu SEC filing and ZeBU 08-2002 description);

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- At least one server coupled to the at least one database, the at least one server adapted to host a web-based system for allowing collaboration among the participants via the Internet (ZeBU software, as evidenced by ZeBu SEC filing);
- At least one client coupled to the at least one server, the at least one client adapted to allow access to the web-based system (ZeBU software, as evidenced by ZeBULLETIN, April 2001, “ZeBU Introduces ZeBU NET);
- Wherein the web-based system comprises a multi-layer, modular architecture, the multi-layer modular architecture including a plurality of applications, each application in the plurality of applications including a plurality of modules and employing a desktop visual metaphor for accessing the plurality of modules (ZeBU Solutions – AIMSuite Overview, SEC filing, page 90, components of AIM suite. The Examiner notes that the web-based system, as claimed, may include modules that are web based and those that are not web based and still anticipate this limitation. The Applications may or may not be web based and only require a visual metaphor for use.); and
- Wherein the participants comprise at least one user, and the web-based system is adapted to restrict the plurality of data accessible to the at least one user based on a plurality of attributes of the at least one user (ZeBU Software, Secure Internet access to application status, policy data, agent and company data).

9. As per claim 21, ZeBU teaches the system of claim 20 as described above. ZeBU further teaches the system wherein the plurality of data comprises data related to an insurance client (The ZeBU HUB solution. The Examiner notes that the particular data is considered non-functional descriptive information and therefore has no patentable weight).

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10. As per claim 22, ZeBU teaches the system of claim 20 as described above. ZeBU further teaches the system wherein the plurality of data comprises data related to an insurance case or policy (The ZeBU HUB solution. The Examiner notes that the particular data is considered non-functional descriptive information and therefore has no patentable weight).

11. As per claim 23, ZeBU teaches the system of claim 20 as described above. ZeBU further teaches the system further comprising:

- A data-translation engine (ZeBU software, as evidenced by ZeBULLETIN, April 2001, ZeBU QUIC);
- A workflow engine (System Administration);
- A web-application-transactional engine (ZeBU Solutions –AIMSuite Overview, HUB);
- and
- A business-rules engine (AIM Home Office- makes underwriting decisions).

12. As per claim 24, ZeBU teaches the system of claim 23 as described above. ZeBU further teaches the system wherein the web-application-transactional engine is adapted to send the plurality of data to, and receive the plurality of data from, at least one application associated with the web-based system (ZeBU Solutions –AIMSuite Overview, HUB is being used as prior art to anticipate this claim. The Examiner further notes that the system does not require the entire device to be “web-based” but merely have some amount of web-based presence.).

13. As per claim 25 ZeBU teaches the system of claim 23 as described above. ZeBU further teaches the system wherein the data-translation engine is adapted to translate and format the plurality of data as the plurality of data is shared among the participants (ZeBU Solutions –AIMSuite Overview, QuickView.).

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14. As per claim 26 ZeBU teaches the system of claim 25 as described above. ZeBU further teaches the system wherein the data-translation engine ensures that a receiving party can receive the plurality of data in a preferred format without manual transcribing (ZeBU Solutions – AIMSuite OverView, QuickView as evidenced by the ZeBulletin, November 2000, “AIM QV/ GA Integration is Here!”).

15. As per claim 27 ZeBU teaches the system of claim 23 as described above. ZeBU further teaches the system wherein the workflow engine implements a plurality of workflows comprising a plurality of tasks and subtasks executed in a predefined sequence (ZeBU Hub and Web QuickView where the predetermined sequence is whether you have a login or not).

In support of the Examiner’s rejection, the Examiner quotes paragraph 34 of the Applicant's specification, “[0034] Fig. 7 shows, in accordance with one embodiment of the present invention, the sequence for user login and authentication.”

16. As per claim 28 ZeBU teaches the system of claim 23 as described above. ZeBU further teaches the system wherein the plurality of workflows comprises at least one public workflow and at least one private workflow (ZeBU HUB. The Examiner notes that the type of workflow represents non-functional descriptive information. Additionally, ZeBu Solutions includes, “ZeBU provides field applications, connectivity solutions, and Web-enabled database applications that organize workflow, provide intracompany and intercompany connectivity, and manage new business for large, geographically and organizationally diverse insurance companies and financial institutions.” Where the private workflow is intra-company and the public workflow is inter-company.).

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17. As per claim 32 ZeBU teaches a method for facilitating communication among a plurality of participants in an insurance-underwriting process, the method comprising:

- storing a plurality of insurance-underwriting data (ZeBU software, as evidenced by ZeBu SEC filing and ZeBU 08-2002 description);
- providing a desktop visual metaphor to a plurality of users over a communications network (ZeBU Solutions – AIMSuite Overview, SEC filing, page 90, components of AIM suite.);
- providing access to a plurality of modules of an application through the desktop visual metaphor, said modules operable to access the insurance-underwriting data (ZeBU software, as evidenced by ZeBULLETIN, April 2001, “ZeBU Introduces ZeBU NET); and
- facilitating, through the desktop visual metaphor, transfer of data among said users (ZeBU Solutions –AIMSuite Overview, QuickView.).

18. As per claim 34 ZeBU teaches the method of claim 23 as described above. ZeBU further teaches the method comprising:

- receiving a request to create a case through the desktop visual metaphor (ZeBU’s Quick Issue Capability – create a new application); and
- storing information relevant to the case (ZeBU’s Quick Issue Capability – upload information or staging information).

19. As per claim 35 ZeBU teaches the method of claim 34 as described above. ZeBU further teaches the method comprising:

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- receiving a request to track the case through the desktop visual metaphor (ZeBU GA, track); and
- displaying through the desktop visual metaphor a status of the case based on the information relevant to the case (ZeBU GA, report).

Claim Rejections - 35 USC § 103

20. ***Claims 29 – 31, 32, 36, 38 – 42 and 44 are*** rejected under 35 U.S.C. 103(a) as being obvious over ZeBU Corporation software, herein referred to as ZeBU, in view of Allport, U.S. Pre-Grant Number 2001/ 0030644.

21. As per claim 29, ZeBU teaches the system of claim 20 as described above.

ZeBU does not explicitly teach the system wherein said at least one user comprises a plurality of users and wherein the system further comprises a view-state database, the view-state database operable to track, for said plurality of users, a current state of a plurality of views of a plurality of said modules (The Examiner notes that the duplication of one user to a plurality of users is a prima face obvious duplication).

However, Allport further teaches the system wherein said at least one user comprises a plurality of users and wherein the system further comprises a view-state database, the view-state database operable to track, for said plurality of users, a current state of a plurality of views of a plurality of said modules (Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature into ZeBU. One of ordinary skill in the art at the time of the invention would have added this feature into ZeBU

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- With the motivation to use a controller such that a first user may reinstate a prior system state of the controller associated with that user's prior use thereof, by a relatively simple, quick, and secure log-on procedure (Allport paragraph 3).

22. As per claim 30, ZeBU in view of Allport teaches the system of claim 29 as described above.

ZeBU does not explicitly teach the system wherein the view-state database, for each user of said plurality of users, stores current state of the plurality of views upon log-off of the user (The Examiner notes that the duplication of one user to a plurality of users is a prima face obvious duplication. The plurality of view for the plurality of viewers is likewise obviously duplicated). However, Allport further teaches the system wherein the view-state database, for each user of said plurality of users, stores current state of the plurality of views upon log-off of the user (Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature into ZeBU. One of ordinary skill in the art at the time of the invention would have added this feature into ZeBU

- With the motivation to use a controller such that a first user may reinstate a prior system state of the controller associated with that user's prior use thereof, by a relatively simple, quick, and secure log-on procedure (Allport paragraph 3).

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23. As per claim 31, ZeBU in view of Allport teaches the system of claim 30 as described above.

ZeBU does not explicitly teach the system wherein the view state database restores the current state of the plurality of views upon login of the user (The Examiner notes that the duplication of one user to a plurality of users is a prima face obvious duplication).

However, Allport further teaches the system wherein the view state database restores the current state of the plurality of views upon login of the user (Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature into ZeBU. One of ordinary skill in the art at the time of the invention would have added this feature into ZeBU

- With the motivation to use a controller such that a first user may reinstate a prior system state of the controller associated with that user's prior use thereof, by a relatively simple, quick, and secure log-on procedure (Allport paragraph 3).

24. As per claim 33, ZeBU in view of Allport teaches the method of claim 32 as described above.

ZeBU further teaches the method comprising:

- restricting access to the insurance-underwriting data based on the attributes (ZeBU Software, Secure Internet access to application status, policy data, agent and company data).

ZeBU does not explicitly teach the method comprising:

- storing attributes of a user of said users; and

However, Allport further teaches the method comprising:

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- storing attributes of a user of said users (paragraph 14); and

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature into ZeBU. One of ordinary skill in the art at the time of the invention would have added this feature into ZeBU

- With the motivation to determine the identification of the user (Allport paragraph 14).

25. As per claim 36 ZeBU teaches the method of claim 32 as described above.

ZeBU does not explicitly teach the method

- storing state information of the desktop visual metaphor and
- wherein providing the desktop visual metaphor includes presenting the desktop visual metaphor in accordance with the state information.

However, Allport further teaches the method

- storing state information of the desktop visual metaphor (paragraphs 13 – 15) and
- wherein providing the desktop visual metaphor includes presenting the desktop visual metaphor in accordance with the state information (paragraphs 13 – 15).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add these features into ZeBU. One of ordinary skill in the art at the time of the invention would have added these features into ZeBU

- With the motivation to use a controller such that a first user may reinstate a prior system state of the controller associated with that user's prior use thereof, by a relatively simple, quick, and secure log-on procedure (Allport paragraph 3).

26. As per claim 38,

ZeBU teaches:

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- instructions for directing a plurality of insurance-underwriting data to be stored (ZeBU – Solutions for the Insurance Industry, solutions software and ZeBU software, as evidenced by ZeBu SEC filing and ZeBU 08-2002 description);
- instructions for providing a desktop visual metaphor to a plurality of users over a communications network (ZeBU – Solutions for the Insurance Industry, solutions software and Web QuickView, customers);
- instructions for providing access to a plurality of modules of an application through the desktop visual metaphor, said modules operable to access the insurance-underwriting data (ZeBU – Solutions for the Insurance Industry, solutions software and ZeBU Solutions – AIMSuite Overview, SEC filing, page 90, components of AIM suite. The Examiner notes that the web-based system, as claimed, may include modules that are web based and those that are not web based and still anticipate this limitation. The Applications may or may not be web based and only require a visual metaphor for use.); and
- instructions for facilitating, through the desktop visual metaphor, transfer of data among said users (ZeBU – Solutions for the Insurance Industry, solutions software and ZeBU Solutions – AIMSuite Overview, QuickView.).

ZeBU does not explicitly teach a computer-readable storage medium having stored thereon instructions for causing a processor to facilitate communication among a plurality of participants in an insurance-underwriting process, the computer-readable storage medium including:

However, Allport teaches a computer-readable storage medium having stored thereon instructions for causing a processor to facilitate communication among a plurality of participants

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in an insurance-underwriting process, the computer-readable storage medium including (paragraphs 42 – 44 where the “in an insurance-underwriting process” is considered the intended use of the data):

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature into ZeBU. One of ordinary skill in the art at the time of the invention would have added this feature into ZeBU

- With the motivation to use known systems to operate the software (Allport paragraph 7 – 10).

27. As per claim 39, ZeBU in view of Allport teaches the computer-readable storage medium of claim 38 as described above.

ZeBU further teaches the medium comprising:

- instructions for restricting access to the insurance-underwriting data based on the attributes (ZeBU Software, Secure Internet access to application status, policy data, agent and company data).

ZeBU does not explicitly teach the medium comprising:

- instructions for storing attributes of a user of said users; and

However, Allport further teaches the medium comprising:

- instructions for storing attributes of a user of said users (paragraph 14); and

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature into ZeBU. One of ordinary skill in the art at the time of the invention would have added this feature into ZeBU

- With the motivation to determine the identification of the user (Allport paragraph 14).

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28. As per claim 40, ZeBU in view of Allport teaches the computer-readable storage medium of claim 38 as described above.

ZeBU further teaches the instructions

- for storing information relevant to a case (ZeBU's Quick Issue Capability – upload information or staging information)
- in response to a request to create the case sent through the desktop visual metaphor (ZeBU's Quick Issue Capability – create a new application).

29. As per claim 41, ZeBU in view of Allport teaches the computer-readable storage medium of claim 38 as described above.

ZeBU further teaches the instructions for

- in response to receiving a request to track the case (ZeBU GA, track),
- displaying through the desktop visual metaphor a status of the case based on the information relevant to the case (ZeBU GA, report where the data is considered non-functional).

30. As per claim 42, ZeBU in view of Allport teaches the computer-readable storage medium of claim 38 as described above.

ZeBU does not explicitly teach the instructions for

- storing state information of the desktop visual metaphor and
- wherein said instructions for providing the desktop visual metaphor includes presenting the desktop visual metaphor in accordance with the state information.

However, Allport further teaches the instructions for

- storing state information of the desktop visual metaphor (paragraphs 13 – 15) and

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- wherein said instructions for providing the desktop visual metaphor includes presenting the desktop visual metaphor in accordance with the state information (paragraphs 13 – 15).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add these features into ZeBU. One of ordinary skill in the art at the time of the invention would have added these features into ZeBU

- With the motivation to use a controller such that a first user may reinstate a prior system state of the controller associated with that user's prior use thereof, by a relatively simple, quick, and secure log-on procedure (Allport paragraph 3).

31. As per claim 44, ZeBU in view of Allport teaches the computer-readable storage medium of claim 38 as described above.

ZeBU, as understood, further teaches the instructions wherein the desktop visual metaphor is a graphical user interface including elements that, as perceived by a person using the desktop visual metaphor, operate substantially similar to corresponding elements of an operating system desktop (ZeBu Solutions for the insurance industry – web-enabled).

The Examiner notes that the displayed information represents non-functional descriptive information. Further, “as perceived by a person using the desktop visual metaphor” is considered the intended use of the display and therefore has no patentable weight.

32. ***Claims 37 is*** rejected under 35 U.S.C. 103(a) as being obvious over ZeBU Corporation software, herein referred to as ZeBU.

33. As per claim 37 ZeBU teaches the method of claim 32 as described above.

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ZeBU does not explicitly teaches the method wherein providing access to a plurality of modules includes executing the modules at a location remote from the users.

However, ZeBu does describe the distribution from a ZeBU local site to a ZeBU Hub (ZeBU Quick Issue Capability). Therefore, it would have been prima facie obvious to make the ZeBU software separable amongst multiple locations.

34. ***Claims 43 is*** rejected under 35 U.S.C. 103(a) as being obvious over ZeBU Corporation software, herein referred to as ZeBU, in view of Allport, U.S. Pre-Grant Number 2001/ 0030644, as applied to claim 38 above.

35. As per claim 43, ZeBU in view of Allport teaches the computer-readable storage medium of claim 38 as described above.

ZeBU does not explicitly teaches the instructions for providing access wherein said to the plurality of modules includes instructions for executing the modules at a location remote from the users.

However, ZeBu does describe the distribution from a ZeBU local site to a ZeBU Hub (ZeBU Quick Issue Capability). Therefore, it would have been prima facie obvious to make the ZeBU software separable amongst multiple locations.

Response to Arguments

36. Applicant's arguments, see 35 U.S.C. 112, 2nd paragraph rejections and 35 U.S.C 102(b) rejections, filed 4/30/2009, with respect to claims 4 – 7 and 9 – 19 have been fully considered and are persuasive. The 35 U.S.C. 112, 2nd paragraph rejections and 35 U.S.C 102(b) rejections of claims 4 – 7 and 9 – 19 have been withdrawn.

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37. Applicant's arguments filed 4/30/2009 have been fully considered but they are not persuasive.

- Request for Information
 - The Applicant states, “As best understood by Applicant, based on recollection and review of the cited references, any ZeBU product existing before the present invention did not include those features which are recited in the pending claims, but not taught or disclosed by the cited references.” The Examiner notes that this was stated in Remarks/ Arguments and not within a declaration.
 - The Examiner understands the Applicant's position. ZeBU became Integrated Insurance Technologies. Integrated Insurance Technologies was acquired by Skywire Corporation. Oracle then acquired Skywire. However, the ZeBU software still anticipates the broad claims of the instant application.
 - The language below is repeated from the Office Action dated 1/30/2009. The Examiner repeats the statements as they are still relevant.
 - Regarding the public use or sale of the Applicant's product. The Examiner has made this rejection using the Applicant's own web site. The Applicant's response was to mention that the amended claims, adding structural components, made the Applicant's invention differ from the reference web site. The Examiner includes a second set of web pages from the Applicant's web sites to further support for this rejection. In addition,

the Examiner brings in additional information from the Applicant's SEC filing.

- Lastly, the Examiner notes that the web-based methodology and structure allows for a single web portal and the remaining software and hardware to be displayed using the proprietary structure alleged. However, if the Applicant should later amend the claimed invention to further define all the software modules and applications to be web based, not currently done, it would be a matter of design choice to change a software application from a proprietary system to an open system such as HTML and the Examiner will make that rejection when required.
- The Applicant states that "WEB Quickview is merely a tool within AIMSuite that 'provides a quick method to view pending data.'" The claim requires that the Invention be "web-based" and the only functionality expressly defined as being web-based is "Sharing, via the web-based system, the plurality of data among the at least one participant." WEB Quickview allows for the sharing of data.
- The Applicant states that the Examiner has failed to show anticipation by relying "on the disclosure pertaining to at least two different pieces of software to reject claim 20 under Section 102 (rather than a single prior art reference.)" The Examiner uses the secondary piece of art to show that the structure not found within the primary art reference. The Examiner

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shows a second piece of art, again from the Applicant's own company's publications, that describes the structure the Applicant's invention uses.

- The Examiner suggests that before making future amendments, the Applicant reviews all the Applicant's own in-use work. The Applicant's invention was appears operational more than one year before the effective filing data of the instant application.
- Claims 20 – 31
 - The Applicant states, “In the present rejection, the Office Action cites multiple documents which, as best understood by the Applicant, describes at least two distinct pieces of software: (1) ZeBUNet (as described by ZeBulletin, April 2001) and (2) ZeBU AIMSuite (as described in ZeBU SEC Filing, ZeBU 08-2002, and other references).”
 - The Applicant is entitled to his opinion of the software. As an example and using the same logic as the Applicant: The Applicant would describe a steering wheel of a car and a transmission of a car as two distinct pieces of machinery where the Examiner is using the entire car as anticipatory.
 - The Applicant states, “Even assuming *arguendo* that the Office Action's general rationale for combining multiple references is proper, ‘to anticipate a combination, the combination in its entirety must be old.’ *Worthington v. Souther New Jersey Newspapers, Inc.*, 167 U.S.P.Q. 598, 610” The Applicant further states, “Accordingly, ‘all elements of the invention must be found in a single

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device in the prior art in order to negative novelty.’ *Worthington*, 167 U.S.P.Q. at 610 (emphasis included).

- The Examiner read through the cited *Worthington* case and has copied the relevant sections here:

USPQ 598
Worthington v. Southern New Jersey Newspapers, Inc.
 U.S. District Court District of New Jersey

[3] Patentability - Anticipation - Combining references (► 51.205)

All elements of invention must be found in a single device in prior art in order to negative novelty; there must be identity or substantial similarity between prior device and invention; however, obviousness, unlike anticipation, can be shown by combining elements of several prior art patents, it not being necessary to find all elements in one prior patent.

[3] The initial issue to be determined is whether the 460 patent has been anticipated in the prior art so as to deprive it of novelty. Novelty will not be negated by a finding of one part of the patented device in one prior art patent, another part in a second patent, and so forth. *Imhaeuser v. Buerk*, 101 U.S. 647 (1879). “To anticipate a combination, the combination in its entirety must be old.” *Bristol v. Otis Elevator Co.*, 52 F.2d 772, 773, 10 USPQ 212 (3rd Cir. 1931). It follows that all of the elements of the invention must be found in a single device in the prior art in order to negative novelty. There must be identity or substantial similarity between the prior device and the patentee's invention. *Connecticut Valley Enterprises, Inc. v. United States*, 348 F.2d 949, 146 USPQ 404 (Ct.Cl. 1965).

- The Examiner notes that the Applicant is reading the quote out of context from the case law. There is nothing within the citation that describes non-patent literature. Third, there is nothing within the citation that describes the construction of a “device.”
- In addition, the Applicant's logic is further flawed by again describing a car. A car may have a sales brochure, an owner's manual and a repair manual. All three brochures describe the same car, a device, but show different aspects of the car. Under the Applicant's logic, the three brochures would be three different prior art documents. Actually, the prior art is the car, as described by the brochures.

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- The Applicant states repeatedly, that the references do not show a “desktop visual metaphor.” The Examiner found this language to be broad and therefore not indefinite. However, claim 38 uses different phrasing with “desktop visual metaphor” that now makes claim 38 indefinite.
- 35 U.S.C. 103 Rejections of Claims 29 – 31
 - The Applicant has amended claims 29 – 31 causing the Examiner to change his rejections. The Applicant’s arguments are moot.
- New Claims 32 – 44
 - The Applicant’s general assertion of patentability is not persuasive.

The Applicant is reminded that ZeBU is the Applicant's own invention. The Examiner reminds the Applicant that any potential patent must be a non-obvious improvement over the Applicant’s prior work.

Conclusion

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Valk, U.S. Pre-Grant Publication 2009/ 0089101

Maes, U.S. Patent 7,167,705

Haswell et al., U.S. Patent 6,907,546

39. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3626

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEAL R. SEREBOFF whose telephone number is (571)270-1373. The examiner can normally be reached on Mon thru Thur from 7:30am to 5pm, with 1st Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. R. S./

Examiner, Art Unit 3626

8/10/2009

/Robert Morgan/

Primary Examiner, Art Unit 3626